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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,547	07/08/2003	Blaine R. Southam	200208274-1	9040

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EXAMINER	
JEAN GILLES, JUDE	
ART UNIT	PAPER NUMBER
2143	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/615,547	SOUTHAM ET AL.	
	Examiner	Art Unit	
	Jude J. Jean-Gilles	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is responsive to communication filed on 07/08/2003.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 9, 17, 21, 25, and 28 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 16, and 22 of U.S. Patent No. 6,920,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to a similar method and system of testing a network service using the same steps and limitations.

Furthermore, Claims 1, 9, 17, 21, 25, and 28 of this application conflict with claims 1, 15, and 24 of Application No. 10/617002. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik et al (hereinafter Malik) U.S. Patent No. 6,160,794 in view of Lozinski et al (hereinafter Lozinski) U.S. Patent No. 6,055,306.

Regarding claim 1: Malik discloses the invention substantially as claimed. Malik teaches an method for testing a network service (see abstract; also see fig. 1), the method comprising:

intercepting a message sent by a network service under test and directed to another network service (column 10, lines 57-67); determining whether the message should be redirected to a mock network service that emulates operation of the other network service (column 10, lines 57-67; column 11, lines 1-18); however Malik does not disclose the details of "redirecting the message to the mock network service if it is determined that the message should be so redirected".

In the same field of endeavor, Lozinski discloses "... *Call Redirect via the IP (14) without charge. This application can mimic services which may be available in the switch and need not be charged, but without ACS suppression support if the IP (14) were to implement it, the redirection would be charge to the caller* ..." [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Lozinski's teachings of redirecting the message to the mock network service if it is determined that the

message should be so redirected with the teachings of Malik, for the purpose of improving the ability of a network "...*to provide* method of suppressing call answer supervision by a peripheral device in a telephone network switch, whereby a billing record for the call is not created" as stated by Losinski in lines 30-34 of column 2. By this rationale, **claim 1** is rejected.

Regarding claim 2: the combination Malik- Losinski discloses the method of claim 1, wherein intercepting a message comprises intercepting a request that is related to a request sent to the network service under test from a mock client [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 3: the combination Malik- Losinski the method of claim 1, wherein intercepting a message comprises intercepting the message using a network proxy. The Examiner takes Official Notice that using a proxy network for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use a network proxy in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67; column 11, lines 1-18. By this rationale, claim 3 is rejected.

Regarding claim 4: the combination Malik- Losinski discloses the method of claim 1, wherein intercepting a message comprises intercepting the message using a data handler [see Malik; column 5, lines 45-60].

Regarding claim 5: the combination Malik- Losinski discloses the method of claim 1, wherein determining whether the message should be redirected to a mock network service comprises identifying a network address to which the message is directed [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 6: the combination Malik- Losinski discloses the method of claim 5, wherein determining whether the message should be redirected to a mock network service further comprises searching for the network address in a redirection database [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 7: the combination Malik- Losinski discloses the method of claim 6, wherein redirecting the message to the mock network service comprises redirecting the message to a network address associated with the network address searched for in the redirection database [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 8: the combination Malik- Losinski discloses the method of claim 1, further comprising receiving a response from a mock network service and transmitting the response to the network service under test [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; see Malik; column 10, lines 57-67; column 11, lines 1-18].

Regarding claim 9: the combination Malik- Losinski discloses a system for testing a network service (see Malik; abstract; also see fig. 1), the system comprising: means for intercepting a message transmitted by a local network service under test and intended for receipt by an external network service; means for determining whether the message should be redirected to a mock network service that emulates operation of the external network service (see Malik; column 10, lines 57-67; column 11, lines 1-18); and means for redirecting the message to the mock network service [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 10: the combination Malik- Losinski discloses the system of claim 9, wherein the means for intercepting a message comprise a network proxy. The Examiner takes Official Notice that using a proxy network for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use a network proxy in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67; column 11, lines 1-18. By this rationale, claim 10 is rejected.

Regarding claim 11: the combination Malik- Losinski discloses the system of claim 9, wherein the means for intercepting a message comprise a data handler [see Malik; column 5, lines 45-60].

Regarding claim 12: the combination Malik- Losinski discloses the system of claim 9,

wherein the means for determining whether the message should be redirected to a mock network service comprise a redirection database [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 13: the combination Malik- Losinski discloses the system of claim 12, wherein the redirection database comprises a table that forms part of a redirection service [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 14: the combination Malik- Losinski discloses the system of claim 13, wherein the table associates network addresses of external network services to network addresses of mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 15: the combination Malik- Losinski discloses the system of claim 14, wherein the table associates universal resource locators (URLs) of external network services to universal resource locators (URLs) of mock network services. The Examiner takes Official Notice that using URLs for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use URLs in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67; column 11, lines 1-18. By this rationale, claim 15 is rejected.

Regarding claim 16: the combination Malik- Losinski discloses the system of claim 9, further comprising means for receiving a response from a mock network service and means for transmitting the response to the network service under test. [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; see Malik; column 10, lines 57-67; column 11, lines 1-18].

Regarding claim 17: the combination Malik- Losinski discloses a system stored on a computer-readable medium, the system comprising: logic configured to intercept messages transmitted by a network service under test and intended for external network services; logic configured to determine whether the messages should be redirected to mock network services that emulate operation of the external network services (see Malik; column 10, lines 57-67; column 11, lines 1-18); and logic configured to redirect the messages to the mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 18: the combination Malik- Losinski discloses the system of claim 17, wherein the logic configured to intercept comprises a network proxy. The Examiner takes Official Notice that using a proxy network for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use a network proxy in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67;

column 11, lines 1-18. By this rationale, claim 18 is rejected.

Regarding claim 19: the combination Malik- Losinski discloses the system of claim 17, wherein the logic configured to intercept comprises a data handler [see Malik; column 5, lines 45-60].

Regarding claim 20: the combination Malik- Losinski discloses the system of claim 17, wherein the logic configured to determine comprises a redirection database that associates network addresses of external network services to network addresses of mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 21: the combination Malik- Losinski discloses a redirector for use in testing a network service, the redirector being configured to: receive a message transmitted by a network service under test and intended for an external network service; determine whether the message should be redirected to a mock network service that emulates operation of the external network service (see Malik; column 10, lines 57-67; column 11, lines 1-18); and redirect the message to the mock network service if the message is determined to be so redirected [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 22: the combination Malik- Losinski discloses the redirector of claim 21, wherein the redirector comprises a network proxy. The Examiner takes Official

Notice that using a proxy network for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use a network proxy in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67; column 11, lines 1-18. By this rationale, claim 22 is rejected.

Regarding claim 23: the combination Malik- Losinski discloses the redirector of claim 21, wherein the redirector comprises a data handler [see Malik; column 5, lines 45-60].

Regarding claim 24: the combination Malik- Losinski discloses the redirector of claim 21, wherein the redirector comprises a redirection database that associates network addresses of external network services to network addresses of mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 25: the combination Malik- Losinski discloses a network proxy stored on a computer-readable medium, the network proxy comprising: logic configured to intercept a message transmitted by a network service under test and intended for an external network service; logic configured to determine whether the message should be redirected to a mock network service that emulates operation of the external network service (see Malik; column 10, lines 57-67; column 11, lines 1-18); and logic configured to redirect the message to the mock network service [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 26: the combination Malik- Losinski discloses the network proxy of claim 25, wherein the logic configured to intercept a message comprises logic configured to intercept extensible markup language (XML) messages wrapped in simple object access protocol (SOAP) envelopes. The Examiner takes Official Notice that using (XML) messages wrapped in simple object access protocol (SOAP) envelopes for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use (XML) messages wrapped in simple object access protocol (SOAP) envelopes in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67; column 11, lines 1-18. By this rationale, claim 29 is rejected.

Regarding claim 27: the combination Malik- Losinski discloses the network proxy of claim 25, wherein the logic configured to determine comprises a redirection database that associates network addresses of external network services to network addresses of mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Regarding claim 28: the combination Malik- Losinski discloses a data handler stored on a computer-readable medium and configured for integration with a network service, the data handler comprising: logic configured to intercept messages transmitted by the network service that are intended for external network services; logic configured to determine whether the messages should be redirected to one or more mock network

services that emulate operation of the external network services (see Malik; column 10, lines 57-67; column 11, lines 1-18); and logic configured to redirect the messages to the one or more mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5].

Regarding claim 29: the combination Malik- Losinski discloses the data handler of claim 28, wherein the data handler comprises a simple object access protocol (SOAP) message handler, and the logic configured to intercept messages comprises logic configured to intercept extensible markup language (XML) messages wrapped in simple object access protocol (SOAP) envelopes. The Examiner takes Official Notice that using (XML) messages wrapped in simple object access protocol (SOAP) envelopes for redirecting network services is well-known in the art. Accordingly, it would have been obvious for an ordinary skill in the art to use (XML) messages wrapped in simple object access protocol (SOAP) envelopes in combination with the teachings of Losinski in column 6, lines 8-13, and column 10, lines 1-5, and the teachings of Malik in column 10, lines 57-67; column 11, lines 1-18. By this rationale, claim 29 is rejected.

Regarding claim 30: the combination Malik- Losinski discloses the data handler of claim 28, wherein the logic configured to determine comprises a redirection database that associates network addresses of external network services to network addresses of mock network services [see Lozinski; column 6, lines 8-13, and column 10, lines 1-5; column 4, lines 31-40].

Conclusion

4. **THIS ACTION IS MADE NON-FINAL**. The Examiner strongly anticipates a Final Rejection Office Action on the next response if amendments are not properly made to the claims to perhaps place them in condition for allowance.

Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

Patent Examiner

Art Unit 2143

JJG

December 22, 2006

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